

### **REMARKS/ARGUMENTS**

Claims 1-30 are pending in the present application.

This response is to respond the non-final Office Action mailed April 14, 2008. In the Office Action, the Examiner rejected claims 1-30 under 35 U.S.C. §103(a). Applicant has amended claims 1, 8, 10, 11, 18, 21, and 28. Reconsideration in light of the amendments and remarks made herein is respectfully requested.

#### ***Rejection Under 35 U.S.C. § 103***

In the Office Action, the Examiner rejected claims 1-3, 5-9, 11-13, 15-19, 21-23, and 25-29 under 35 U.S.C. §103(a) as being unpatentable over U.S. Publication No. 2002/0037107A1 issued to Trachtman ("Trachtman") in view of U.S. Publication No. 2006/0037107A1 issued to Clary ("Clary"); and claims 4, 10, 14, 20, 24, and 30 under 35 U.S.C. §103(a) as being unpatentable over Trachtman in view of Clary and further in view of U.S. Publication No. 2006/0148527A1 issued to Blount ("Blount"). Applicant respectfully traverses the rejection and submits that the Examiner has not met the burden of establishing a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *MPEP §2143, p. 2100-126 to 2100-130 (8th Ed., Rev. 5, August 2006)*. Applicant respectfully submits that there is no suggestion or motivation to combine their teachings, and thus no *prima facie* case of obviousness has been established.

Furthermore, the Supreme Court in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966), stated: "Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined." *MPEP 2141*. In *KSR International Co. vs. Teleflex, Inc.*, 127 S.Ct. 1727 (2007) (Kennedy, J.), the Court explained that "[o]ften, it will be

necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue." The Court further required that an explicit analysis for this reason must be made. "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR 127 S.Ct.* at 1741, quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). In the instant case, Applicant respectfully submits that there are significant differences between the cited references and the claimed invention and there is no apparent reason to combine the known elements in the manner as claimed, and thus no *prima facie* case of obviousness has been established.

1. Claims 1-3, 5-9, 11-13, 15-19, 21-23, and 25-29:

Trachtman discloses image communications. A calling facsimile terminal 24 comprises an input device 30 and a facsimile transmission microprocessor 32 which encodes signals from the input device 30 according to a predetermined algorithm (Trachtman, paragraph [0045]). The facsimile transmission microprocessor 32 also controls the operation of facsimile transmission, including call set-up, pre-message procedure, message transmission, post-message procedure and call release (Trachtman, paragraph [0045]). Connected to read a frame store 104, in parallel, are an optical character recognition (OCR) circuit 106 followed by a text compression circuit 107; a graphics coder circuit 108; and an image coder circuit 110. Each may be provided by a suitably programmed microprocessor, microcontroller or digital signal processing (DSP) chip (Trachtman, paragraph [0045]). A transmission control unit 38 encodes the data and an output buffer 40 from which encoded data is transferred to the fixed earth station 18 (Trachtman, paragraph [0046]). A graphics coder 108 encodes the line graphics areas identified by a segmenter 112 and generates corresponding line output data to a formatter 114 (Trachtman, paragraph [0068]). An OCR circuit 106 and text compression circuit 107 generate a stream of compressed digital data representing text characters encoding the text areas (Trachtman, paragraph [0069]). The outputs of the text compression circuit 107, the graphics coder circuit 108 and the image coder circuit 110 are supplied to a formatter device 114 which combines all three into a frame or packet

format for supply to the output buffer 40 or a store 116 (Trachtman, paragraph [0056]). A header portion 750 consists of conventional facsimile signaling data, identifies the message as being a compressed facsimile message, and identifies the type of compression used (Trachtman, paragraph [0135]).

Clary discloses system and method for editing handwritten data. A pen enabled computing device edits the data upon actuation of the editing actuator (Clary, paragraph [0015], lines 3-5). A ninth executable portion enables editing of data upon actuation of the editing actuator (Clary, paragraph [0021], lines 5-7). An editing actuator is actuated in order to enable the pen enabled computing device to edit the data (Clary, paragraph [0028], lines 8-11).

Trachtman and Clary, taken alone or in any combination, do not disclose or render obvious, at least one of: (1) an encoder to encode data in a first format from an input device into a string of data having a second format, the first and second formats being different; (2) a packetizer coupled to the encoder to packetize the string of data into at least one packet having a header, the header identifying the first format; and (3) a management layer coupled to the packetizer to process the packetized string of data using a processing function, the processing function being enabled or disabled using a configuration user interface.

First, Trachtman merely discloses an OCR circuit 106 and text compression circuit 107 generate a stream of compressed digital data representing text characters encoding the text areas (Trachtman, paragraph [0069]), NOT an encoder to encode data in a first format from an input device into a string of data having a second format, the first and second formats being different. The OCR circuit 106 is used to perform OCR operations to recognize text. The text compression circuit 107 compresses the text. None of them encodes the data into a string. Furthermore, since there is no first format, none of them can encode data in a second format different from the first format. Moreover, the text characters encode the text areas. These characters cannot and do not encode data into a string of data.

Second, Trachtman merely discloses a formatter device 114 which combines all three outputs of the text compression circuit 107, the graphics coder circuit 108 and the image coder circuit 110 into a frame or packet format for supply to the output buffer 40 or a store 116 (Trachtman, paragraph [0056]), NOT a packetizer coupled to the encoder to packetize the string of data into at least one packet having a header, the header identifying the first format. The

header portion 750 merely identifies the message as being a compressed facsimile message, and identifies the type of compression used (Trachtman, paragraph [0135]). It does not identify the first format. Compression is to reduce the amount of data. It is not a format that the data is encoded in. Furthermore, since Trachtman does not disclose an encoder as discussed above, there is no first format.

Third, Trachtman merely discloses a microprocessor 32 controls the operation of facsimile transmission, including call set-up, pre-message procedure, message transmission, post-message procedure and call release (Trachtman, paragraph [0045]), NOT a management layer to process the packetized string of data using a processing function, the processing function being enabled or disabled using a configuration user interface. Controlling the operation of facsimile transmission does not involve process data using a processing function. The call set-up, pre-message procedure, message transmission, etc. merely operate on the operation of a facsimile transmission. None of these is related to processing data.

Fourth, Clary merely discloses an executable portion that enables editing of data upon actuation of the editing actuator (Clary, paragraph [0021], lines 5-7), not a management layer to process the packetized string of data using a processing function the processing function being enabled or disabled using a configuration user interface. Enabling editing of data is not the same as processing the packetized string of data. The data to be edited is the handwritten data (Clary, paragraph [0028], lines 1-5), not a packetized string of data. In addition, the editing function is performed by the pen enabled computing device, not by a management layer.

Moreover, modifying Trachtman to incorporate the teachings of Clary would render the Trachtman technique being modified unsatisfactory for its intended purpose, or change its principle of operation. If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). If the proposed modification or combination of the prior art would change the principle of operation of the prior invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). Here, modifying Trachtman to incorporate the execution portion to enable the editing of data by a pen enabled computing device would render the Trachtman technique

unworkable because Trachtman technique involves a facsimile transmission of data. The facsimile transmission does not involve human editing while the pen enabled computing device requires a human operator to perform the editing. Accordingly, there is no suggestion or motivation to make the proposed modification.

2. Claims 4, 10, 14, 20, 24, and 30:

Trachtman and Clary are discussed above.

Blount discloses mobile graphics device and server. A facility exchanges hand drawn graphics images between graphics devices and a corresponding graphics device (Blount, paragraph [0030], lines 1-4). A list of pre-defined group may be established using an instant messaging system. The arrangement of data indicating the presence of a user for responding to an availability for exchanging hand drawn graphics may be provided in accordance with an instant messaging server (Blount, paragraph [0030], lines 7-9; lines 15-20).

Trachtman, Clary, and Blount, taken alone or in any combination, do not disclose or render obvious, at least one of: (1) an encoder to encode data in a first format from an input device into a string of data having a second format, the first and second formats being different; (2) a packetizer coupled to the encoder to packetize the string of data into at least one packet having a header, the header identifying the first format; and (3) a management layer coupled to the packetizer to process the packetized string of data using a processing function, the processing function being enabled or disabled using a configuration user interface; as recited in claims 1, 8, 11, 18, 21, and 28; and (4) the network comprises an instant messaging (IM) infrastructure; as recited in claims 4, 10, 14, 20, 24, and 30.

As discussed above, Trachtman and Clary, taken alone or in combination, do not disclose or render obvious elements (1) – (3) as above. Accordingly, a combination of Trachtman and Clary with any other references in rejecting claims 4, 10, 14, 20, 24, and 30, which depend on claims 1, 8, 11, 18, 21, and 28, respectively, is improper.

Furthermore, Applicant submits that Blount is not a proper prior art. The earliest priority date of Blount established by the provisional application is December 18, 2002, which is predated by the filing date of the current application.

The Examiner failed to establish a prima facie case of obviousness and failed to show there is teaching, suggestion, or motivation to combine the references. When applying 35 U.S.C.

103, the following tenets of patent law must be adhered to: (A) The claimed invention must be considered as a whole; (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination; (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and (D) Reasonable expectation of success is the standard with which obviousness is determined. *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986). "When determining the patentability of a claimed invention which combined two known elements, 'the question is whether there is something in the prior art as a whole suggest the desirability, and thus the obviousness, of making the combination.'" *In re Beattie*, 974 F.2d 1309, 1312 (Fed. Cir. 1992), 24 USPQ2d 1040; *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1462, 221 USPQ (BNA) 481, 488 (Fed. Cir. 1984). To defeat patentability based on obviousness, the suggestion to make the new product having the claimed characteristics must come from the prior art, not from the hindsight knowledge of the invention. *Interconnect Planning Corp. v. Feil*, 744 F.2d 1132, 1143, 227 USPQ (BNA) 543, 551 (Fed. Cir. 1985). To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the Examiner to show a motivation to combine the references that create the case of obviousness. In other words, the Examiner must show reasons that a skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the prior elements from the cited prior references for combination in the manner claimed. *In re Rouffet*, 149 F.3d 1350 (Fed. Cir. 1996), 47 USPQ 2d (BNA) 1453. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or implicitly suggest the claimed invention or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973. (Bd.Pat.App.&Inter. 1985). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Furthermore, although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation

in the reference to do so.” *In re Mills*, 916 F.2d at 682, 16 USPQ2d at 1432; *In re Fritch*, 972 F.2d 1260 (Fed. Cir. 1992), 23 USPQ2d 1780.

Moreover, the Examiner failed to establish the factual inquires in the three-pronged test as required by the *Graham* factual inquires. There are significant differences between the cited references and the claimed invention as discussed above. Furthermore, the Examiner has not made an explicit analysis on the apparent reason to combine the known elements in the fashion in the claimed invention. Accordingly, there is no apparent reason to combine the teachings of Trachtman, Clary, and Blount.

In the present invention, the cited references do not expressly or implicitly disclose any of the above elements. In addition, the Examiner failed to present a convincing line of reasoning as to why a combination of Trachtman, Clary, and Blount is an obvious application of transmitting new data format under existing infrastructure, or an explicit analysis on the apparent reason to combine Trachtman, Clary, and Blount in the manner as claimed.

Therefore, Applicants believe that independent claims 1, 8, 11, 18, 21, 28 and their respective dependent claims are distinguishable over the cited prior art references. Accordingly, Applicants respectfully request the rejection under 35 U.S.C. §103(a) be withdrawn.

*Conclusion*

Applicants respectfully request that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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